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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/006,648	12/10/2001	Noriyoshi Shida	Q67621	2208
7590 02/25/2005 SUGHRUE, MION, ZINN, MACPEAK & SEAS, PLLC 2100 Pennsylvania Avenue, N.W. Washington, DC 20037-3202			EXAMINER JOLLEY, KIRSTEN	
			ART UNIT 1762	PAPER NUMBER

DATE MAILED: 02/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

41

Office Action Summary	Application No. 10/006,648	Applicant(s) SHIDA ET AL.	
	Examiner Kirsten C Jolley	Art Unit 1762	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 December 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5, 15 and 23-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 15 and 23-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>7/29/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on December 14, 2004 has been entered.

Drawings

2. The drawings were received on December 14, 2004. These drawings are accepted.

Response to Arguments

3. The 35 USC 102 rejections over JP 10-289489 A, Komaki et al., Kikuchi '985, and Kikuchi '349 have been withdrawn in response to Applicant's amendments to claim 1 requiring that the film forming liquid is supplied directly in contact with an outer peripheral face of the film forming jig. Support for the amended limitation is illustrated in the drawings of the specification.

4. Applicant's arguments regarding the Plows et al. and JP 1-195250 A references filed December 14, 2004 have been fully considered but they are not persuasive. Applicant argues that the cited references do not disclose a structure which supplies the film forming liquid directly to the outer peripheral face of the film forming jig. Applicant argues that the liquid is

Art Unit: 1762

supplied directly to the face 2b (as shown in Figures 1A and 2B), which is provided at the outer periphery of the jig, and thus the supply portion is also provided at this face 2b. The Examiner acknowledges that the references having a ring-shaped jig, and therefore an outer peripheral face 2b as illustrated in Figures 1A and 2B, do not teach supplying the film forming liquid directly to face 2b, and therefore the rejections over those references have been withdrawn. However, with respect to the Plows et al. reference, which has a conical-shaped jig, Applicant's specification itself teaches that the outer peripheral face of a conical jig is the downwardly-sloped surface 22b (as illustrated in Figures 7 and 8B and discussed on page 17). It is the Examiner's position that the film forming liquid in Plows et al.'s apparatus is supplied directly to the downwardly-sloped surface of the conical jig, or the jig's outer peripheral face. Figure 1 of Plows et al. illustrates that the film forming liquid is supplied at the apex of the cone, however the applicator is illustrated as having a wider diameter than the apex of the cone. Therefore it is the Examiner's position that some of the liquid is necessarily supplied directly to the downwardly-sloping surface of the conical jig, or the outer peripheral face.

Similarly, with respect to the JP 11-195250 reference, the outer peripheral face of the jig illustrated in Figure 4 would be the upper, downwardly-sloping surface of the circular jig. Figure 3 illustrates that the film forming liquid is supplied directly to that surface, the outer peripheral face.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

Art Unit: 1762

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-2, 4, 15, 23, and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by Plows et al. (US 4,075,974).

7. Plows et al. discloses a film forming apparatus comprising a rotating unit (spindle 7) for rotating a substrate (disk 15), and a film forming jig (distributor 31) which is placed on the disk substrate, whereby film forming liquid is supplied to an outer periphery of the film forming jig and the rotation unit is rotated to form a film (col. 3, lines 21-32 and 50-66). When the substrate and jig are rotated together with film forming liquid thereon, the film forming liquid will spread over the surface and down the side of the jig. Applicant's specification teaches that the outer peripheral face of a conical jig is the downwardly-sloped surface 22b (as illustrated in Figures 7 and 8B and discussed on page 17). It is the Examiner's position that the film forming liquid in Plows et al.'s apparatus is supplied directly to the downwardly-sloped surface of the conical jig, or the jig's outer peripheral face. Figure 1 of Plows et al. illustrates that the film forming liquid is supplied at the apex of the cone, however the applicator is illustrated as having a wider diameter than the apex of the cone. Therefore it is the Examiner's position that some of the liquid is necessarily supplied directly to the downwardly-sloping surface of the conical jig, or the outer peripheral face.

As to claims 2 and 4, the substantially conical jig/distributor 31 illustrated in Figure 1 has a thickness larger than that of the film formed.

Art Unit: 1762

As to claim 15, it is well settled that the intended uses of and the particular material used in a coating apparatus have no significance in determining patentability of apparatus claims. *Ex parte Thibault*, 164 USPQ 666 (Bd. Pat. App. 1969).

As to claims 23 and 25, the outer peripheral face of Plows et al.'s conical jig is a peripheral side surface of the jig, and the supply portion is disposed directly adjacent to the peripheral side surface.

8. Claims 1-5, 15, and 23-25 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 11-195250 A.

JP '250 discloses a film forming apparatus comprising a rotating unit for rotating a substrate 3, and a film forming jig 2 which is placed on the substrate, whereby liquid is applied to an outer periphery of the film forming jig as illustrated in Figure 3 and the rotation unit is rotated to form a film. When the substrate and jig are rotated together with film forming liquid thereon, the film forming liquid will spread over the surface and down the side of the jig. The outer peripheral face of the jig illustrated in Figure 4 would be the upper, downwardly-sloping surface of the circular jig. Figure 3 illustrates that the film forming liquid is supplied directly to that surface, the outer peripheral face.

As to claim 2, Figure 3 also illustrates that a thickness of the film forming jig 2 is larger than that of the film 1. As to claims 3-5, it is the Examiner's position that film forming jig 2 of Figure 4 may be considered to have a *substantially* conical shape, *substantially* cylindrical shape, or *substantially* truncated conical shape.

As to claim 15, the substrate is an optical disc substrate.

Art Unit: 1762


As to claims 23-25, the outer peripheral face of JP '250's jig 2 of Figure 4 is a peripheral side surface of the jig, and the supply portion is disposed directly adjacent to the peripheral side surface as illustrated in Figure 3. Since there is not an upper surface of the film forming jig separate from the outer peripheral face, it is the Examiner's position that the apparatus of JP '250 meets the limitation of claim 24.

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kirsten C Jolley whose telephone number is 571-272-1421. The examiner can normally be reached on Monday to Thursday and every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shrive P Beck can be reached on 571-272-1415. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Kirsten C Jolley
Primary Examiner
Art Unit 1762

kcj